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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/633,694	08/05/2003	Jeffrey A. Anderson	14917.0002	7611
27890 7590 02/17/2009 STEP TOE & JOHNSON LLP 1330 CONNECTICUT AVENUE, N.W. WASHINGTON, DC 20036				
EXAMINER CHAPMAN, JEANETTE E				
ART UNIT 3633		PAPER NUMBER		
MAIL DATE 02/17/2009		DELIVERY MODE PAPER		

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary**Application No.**

10/633,694

Applicant(s)

ANDERSON, JEFFREY A.

Examiner

Jeanette E. Chapman

Art Unit

3633

Period for Reply -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 24 October 2007.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1, 3-15, 27-30, 32-34, 36-51 and 53-58 is/are pending in the application.
- 4a) Of the above claim(s) 27-30, 32-34, 36-41, 43-49, 50-51, 53, 56, 57, 58 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1, 3-15, 44, 54 and 55 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

In view of the appeal brief filed on 10/29/08, PROSECUTION IS HEREBY REOPENED. A new non-final office action including a restriction requirement has been set forth below.

To avoid abandonment of the application, appellant must exercise one of the following two options:

(1) file a reply under 37 CFR 1.111 (if this Office action is non-final) or a reply under 37 CFR 1.113 (if this Office action is final); or,

(2) initiate a new appeal by filing a notice of appeal under 37 CFR 41.31 followed by an appeal brief under 37 CFR 41.37. The previously paid notice of appeal fee and appeal brief fee can be applied to the new appeal. If, however, the appeal fees set forth in 37 CFR 41.20 have been increased since they were previously paid, then appellant must pay the difference between the increased fees and the amount previously paid.

A Supervisory Patent Examiner (SPE) has approved of reopening prosecution by signing below:

/Brian Glessner/
Supervisory Patent Examiner
Art unit 3633.

Election/Restrictions

DETAILED ACTION

Election/Restrictions

Restriction to one of the following inventions is required under 35 U.S.C. 121:

- I. Claims 1,3-15, 44, 54-55, drawn to the metal framing member, classified in class 52, subclass 633.
- II. Claims 27-30,32-34, 36-41,49-50, 53, 56, 58, drawn to a method of manufacturing, classified in class 52, subclass 745.17.
- III. Claims 42-43, 51, 57 drawn to a method of Building, classified in class 52, subclass 741.14.

The inventions are distinct, each from the other because of the following reasons:

Inventions group I and group II and group III are related as process of making and product made. The inventions are distinct if either or both of the following can be shown: (1) that the process as claimed can be used to make another and materially different product or (2) that the product as claimed can be made by another and materially different process (MPEP § 806.05(f)). In the instant case the stamping and roll forming method steps are not needed to make the metal framing member; piercing and other metal forming processes could be used. Further, the method of installing wiring plumbing or a heat duct through the void member is not necessary to the article

claim or method of manufacturing because the framing member could be used in a frame without the installation of wiring.

Restriction for examination purposes as indicated is proper because all these inventions listed in this action are independent or distinct for the reasons given above and there would be a serious search and examination burden if restriction were not required because one or more of the following reasons apply:

- (a) the inventions have acquired a separate status in the art in view of their different classification;
- (b) the inventions have acquired a separate status in the art due to their recognized divergent subject matter;
- (c) the inventions require a different field of search (for example, searching different classes/subclasses or electronic resources, or employing different search queries);
- (d) the prior art applicable to one invention would not likely be applicable to another invention;
- (e) the inventions are likely to raise different non-prior art issues under 35 U.S.C. 101 and/or 35 U.S.C. 112, first paragraph.

Applicant is advised that the reply to this requirement to be complete must include (i) an election of a invention to be examined even though the requirement may be traversed (37 CFR 1.143) **and (ii) identification of the claims encompassing the elected invention.**

The election of an invention may be made with or without traverse. To reserve a right to petition, the election must be made with traverse. If the reply does not distinctly and specifically point out supposed errors in the restriction requirement, the election shall be treated as an election without traverse. Traversal must be presented at the time of election in order to be considered timely. Failure to timely traverse the requirement will result in the loss of right to petition under 37 CFR 1.144. If claims are added after the election, applicant must indicate which of these claims are readable on the elected invention.

If claims are added after the election, applicant must indicate which of these claims are readable upon the elected invention.

Should applicant traverse on the ground that the inventions are not patentably distinct, applicant should submit evidence or identify such evidence now of record showing the inventions to be obvious variants or clearly admit on the record that this is the case. In either instance, if the examiner finds one of the inventions unpatentable over the prior art, the evidence or admission may be used in a rejection under 35 U.S.C. 103(a) of the other invention.

During a telephone conversation with Harold Fox (assistant) on 2/12/09 a provisional election was made with traverse to prosecute the invention of group I, claims 1, 3-15, 44, 54, 55. Affirmation of this election must be made by applicant in replying to this Office action. Claims 27-30, 32-34, 36-43, 49-51, 53, 56-57, 58 have withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.

The amendment filed 11/9/06 is objected to under 35 U.S.C. 132(a) because it introduces new matter into the disclosure. 35 U.S.C. 132(a) states that no amendment shall introduce new matter into the disclosure of the invention. The added material which is not supported by the original disclosure is as follows: "the ratio of the distance between adjacent slots prior to expansion to a width of the formed metal sheet prior to expansion is 1:8 or greater".

Applicant is required to cancel the new matter in the reply to this Office Action. Claims 1, 3-15, 44, 54-55 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. See above.

Claim Rejections. 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

Claims 1, 3-5, 9, 11-14, 54-55 are rejected under 35 U.S.C. 103(a) as being unpatentable over Sucato et al (5605024),

claim 1.

Sucato et al discloses a metal framing member comprising: a formed metal sheet having a length and including a web region 64 including a plurality of expanded web slots 65 including voids and metal web elements and extending along a portion of the length, wherein the region includes a plurality of reinforcements 66 proximate to the web slots and confined to the web elements and exclusive to the web voids, and each expanded web slot has a length to width ratio of about 2:1 or greater as shown in figure, and sucato lacks the ratio of the distance between adjacent slots prior to expansion to a width of the formed metal sheet prior to expansion is 1:8 or greater. Applicant has not shown the criticality and relevancy for including these ratios. Applicant has not shown that ratios outside the recited ratios cause the framing member to not function as intended or to function unfavorably. One of ordinary skill in the art would have appreciated providing the proper ration of web slots to voids which would provide the intended framing member with the intended function

2. (Canceled)

claim 3.

Sucato discloses the member of claim 1, wherein the formed metal sheet includes a web region 64 and a first flange 62 extending from the web region 64.

claim 4.

Sucato et al discloses the member of claim 3, wherein the formed metal sheet further includes a second flange 63 extending from the web region 64 in a direction substantially parallel to the first flange 62.

claim 5.

Sucato et al discloses the member of claim 3, wherein the web region 64 includes the expanded web slots. See figures 20-21.

claim 9.

Sucato discloses the member of claim 4, wherein the formed metal sheet further includes a closing region extending the first flange to the second flange to form a substantially tubular structure. See annotations below.

Claim 11.

Sucato discloses that the member of claim 1, wherein each web slot extends along a portion of a length of the member.

Claim 12.

Sucato discloses the member of claim 1, wherein the plurality of web slots is arranged in offset columns substantially parallel to a length of the member. See figures 20-21.

Claim13.

Sucato discloses the member of claim 1, wherein the plurality of web slots form three or more columns of slots along the length of the member. See figures 20-21

Claim 14.

Sucato discloses the member of claim 13, wherein the plurality of web slots form five or more columns of slots along the length of the member. See figures 20-21.

Claim 54.

A metal framing member comprising: a formed metal sheet including a plurality of expanded web slots in a region of the formed metal sheet; sucato does not disclose the

expanded web slots are heat treated: but discloses each expanded web slot having a length to width ratio of 2:1 or greater. Sucato lacks the ratio of the distance between adjacent slots prior to expansion to a width of the formed metal sheet prior to expansion is 1:8 or greater. Applicant has not shown the criticality and relevancy for including these ratios. Applicant has not shown that ratios outside the recited ratios cause the framing member to not function as intended or to function unfavorably. One of ordinary skill in the art would have appreciated providing the proper ration of web slots to voids which would provide the intended framing member with the intended function. Heat treatment is a common process that has been around for many years to strengthen the mechanical metal structure after forming claim 55.

Sucato discloses 66 The member of claim 1, wherein the reinforcements include a dart or dimple 66.

Claims 6-8, 10 are rejected under 35 U.S.C. 103(a) as being unpatentable over Sucato et al (5605024) in view of Ekerholm (6205740) claim 6.

Sucato lacks the member of claim 3, wherein the first flange includes the expanded web slots. Ekerholm discloses a framing member with flanges having expandable regions 2 and 3. It would have been obvious to one of ordinary skill in the art to modify Sucato et al to include the framing member with flanges having expanded web slots to provide more adjustment characteristics to the frame as needed claim 7.

With the modification of Ekerholm to Sucato, the member of claim 3, each of the web region and the first flange includes the expanded web slots.

Claim 8.

With the modification of Ekerholm to Sucato et al, the member of claim 5, each of the web region, the first flange and the second flange includes the expanded web slots.

claim 10.

Sucato discloses discloses the web region includes the expanded web slot and the closing region including the expanded web slots. Ekerholm et al discloses the first flange and the second flange and the closing region includes the expanded web slots. See obviousness rational above for including the ekerholm reference.

Claims 15, 44 are rejected under 35 U.S.C. 103(a) as being unpatentable over Sucato et al (5605024) in view of Bodnar (5527625)

Claim 15.

Bodnar discloses a framing member with voids and reinforcements 100, 102, 104 and additional reinforcements 94/96/98

It would have been obvious to oinclude these reinforcement or flanges to strengthen the from material around the opening or slits.

Claim 44.

Bodnar discloses the reinforcements include a strengthening flange. See obviousness rational above for combining Bodnar with Sucato.

Applicant's arguments have been considered but are not deemed persuasive.

Regarding the Declaration of Roger A. Laboube:

The declaration does not shows the equivalence of the 1:8 ratio and the specification page 6, line 26. Meaning the information in the declaration does not overcome the new matter rejection nor does it overcome or influence in any way the prior art rejection. Further, there is no nexus between what is disclosed in the declaration and what is recited in the claims.

Regarding the Declaration of Francis J. Roost:

The declaration does not shows the equivalence of the 1:8 ratio and the specification page 6, line 26. Meaning the information in the declaration does not overcome the new matter rejection nor does it overcome or influence in any way the prior art rejection. Further, there is no nexus between what is disclosed in the declaration and what is recited in the claims

Regarding exhibits B (Market (2002) in Tons After Applying Factors), C (Derivation of Weight per Foot (interior wall)), D (AMM Steel Base prices), E(derivation of material Savings) and the Data of Non-Statistical Analysis of the use of Cold Formed Steel in no Residential Construction.

The above documents contains an excessive amount of information and data and some directed to commercial success. The claims of commercial success lacks a direct link and relevance to the claims . Further there is no evidence in the document overcoming the prior art or the new matter rejection. Further applicant does not

reference or underline any information within the documents that directly relate to the claim language or provide information in overcoming the new matter rejection.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Chapman E Jeanette whose telephone number is 571-272-6841. The examiner can normally be reached on Mon.-Fri, 8:30-6:00, every other fri. off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Brian Glessner can be reached on 571-272-6843. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

/Jeanette Chapman/
Primary Examiner, Art Unit 3633